

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNY JAEGER

Appeal No. 1998-3127
Application No. 08/703,418

ON BRIEF

Before KRASS, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-4, all of the claims pending in the present the application.

The claimed invention relates to a radio having a plurality of user programmable station selection switch

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buttons which are depressed to select a particular station. A plurality of flat panel display screens, each of which forms a portion of the front surface of separate ones of the switch buttons, are controlled to display indicia which identifies the user selected station on depression of a particular switch button.

Claim 1 is illustrative of the invention and reads as follows:

1. In a radio having a plurality of station selector switches each having a button which may be depressed to select a particular station and having means for enabling a user of the radio to condition each button for selection of a particular station that is chosen by the user, the improvement comprising a plurality of flat panel display screens for generating visible images, each of said screens forming at least a portion of the front surface of a separate one of said buttons, and control means for causing each of said screens to display indicia which identifies the user chosen station that is selected by depression of the particular button.

The Examiner relies on the following prior art:

Goldmacher et al. (Goldmacher)	3,499,702	Mar. 10, 1970
Murao et al. (Murao)	3,922,067	Nov. 25, 1975
Nishimura et al. (Nishimura)	4,295,224	Oct. 13, 1981
Leeder et al. (Leeder)	GB2019628	Oct. 31, 1979

(Published UK Pat. Application)

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Claims 1-3 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Leeder. Claim 4 stands finally rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Leeder, Goldmacher, and Murao.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

¹ The Appeal Brief was filed January 5, 1998. In response to the Examiner's Answer dated March 16, 1998, a Reply Brief was filed April 21, 1998, which was acknowledged and entered by the Examiner without further comment in the communication dated May 29, 1998.

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It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

837

F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some

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teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

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With respect to independent claim 1, the Examiner proposes to modify the radio frequency tuning indicator disclosure of Nishimura which, as illustrated in Figure 1, describes a plurality of user conditionable station selector switch buttons. As recognized by the Examiner, the selector switch buttons of Nishimura do not include a flat panel display screen on the front surface of the buttons as claimed. To address this deficiency, the Examiner turns to Leeder which describes a flat panel display screen incorporated in a programmable function key for displaying a message indicator on the face of the key. In the Examiner's line of reasoning as stated at page 4 of the Answer:

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify each button of Nishimura to have a flat panel display screen as taught by Leeder so as to provide a direct feedback to the operator indicating that the desired key function has been initiated after the key is hit, and to reduce the likelihood of operator confusion, especially in comparison with unlighted keys of the prior art.

In response, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness since the proposed combination of Nishimura and Leeder would not

result in the invention as set forth in independent claim 1 (Brief, page 7). After careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs.

Our review of Leeder finds that, contrary to the Examiner's interpretation, while a message is provided on the programmable keys that changes according to the programmed key function, there is no suggestion that such message is related to the function performed by the keys. The Examiner at least impliedly recognizes this shortcoming of Leeder since the stated rationale for modifying Nishimura with Leeder rests solely on a desire to provide a user with a feedback indication that a desired key function has been initiated. In our view, however, the resulting modification of Nishimura with Leeder would at best provide an indication to a user that a particular switch button has been pressed, but there would be no indication that a particular station selected by depression of the switch button would be identified as required by claim 1.

As to the Examiner's assertion (Answer, page 7) that, since the disclosed programmable key of Leeder can have any

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message selected by a user, a displayed message on the modified key of Nishimura could include radio station identification information, we find no evidentiary support on the record, outside of Appellant's own disclosure, for such an assertion. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Accordingly, we do not sustain the Examiner's obviousness rejection of claim 1, nor of claims 2 and 3 dependent thereon, based on the combination of Nishimura and Leeder.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejection of dependent claim 4 in which the Goldmacher and Murao references are added to the combination of Nishimura and Leeder, we reverse this rejection as well. It is apparent from the Examiner's analysis (Answer, page 5) that Goldmacher and Murao are relied on solely to address the claimed parallel

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busbar conductor structure of the display screen. We find nothing, however, in the disclosures of Goldmacher or Murao which would overcome the innate deficiencies of Nishimura and Leeder discussed supra.

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claim 1 and claims 2-4 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 1-4 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH F. RUGGIERO
Administrative Patent Judge

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APJ RUGGIERO

APJ KRASS

APJ FLEMING

DECISION: REVERSED

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s):

Prepared: September 27, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK

DISK (FOIA) / REPORT